

Attorney's Docket 021058-0257402
Client Reference: 2470303/JCC/MXB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:
HELEN O'HARA ET AL.

Confirmation Number: 3549

Application No.: 09/938,649

Group Art Unit: 1793

Filed: August 27, 2001

Examiner: Felton, Aileen

For: GASSER COMPOSITION AND METHOD OF GASSING

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is in response to the Notice of Non-Compliant Appeal Brief (hereafter "the Notice") mailed April 13, 2009 and in furtherance of the Appeal Brief filed January 5, 2009 (hereafter "Appeal Brief").

Box 6 of the Notice was checked, allegedly indicating that "The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 C.F.R. 41.37(c)(1)(vii)," and the Examiner's comments state "Applicant argues dependent claims separately but does not include a concise explanation of these claims with page and line number in the summary section." Appellant disagrees.

37 C.F.R. 41.37(c)(1)(v) states:

Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and ***for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and***

step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

[Emphasis Added]

Thus, under § 41.37(c)(1)(v) each independent claim must be provided with a concise explanation, but for dependent claims only means-plus-functions limitations of each dependent claim argued separately must be identified. No concise explanation is otherwise required for dependent claims, argued separately, which do not include means-plus-function recitations.

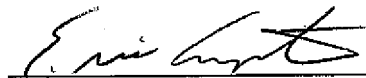
Appellant submits that none of the dependent claims argued separately in the Appeal Brief include means-plus-function recitations under 35 U.S.C. § 112, sixth paragraph, and therefore, do not require any identification of the corresponding structure, material, or acts thereof, described in the specification.

Accordingly, Appellant submits that the Appeal Brief is proper, and that the Notice of Non-Compliant Appeal Brief should be withdrawn.

Nonetheless, without agreeing or acceding to the propriety of the Notice and solely to expedite appeal, Applicant submits herewith a Supplemental Appeal Brief indicating that dependent claims 61, 62-67, 70, 72 and 74-76, do not include any means-plus-function recitations. [See Supplemental Appeal Brief, page 4].

It is believed that no fees are required for filing this Response, however, the Director is hereby authorized to charge any fees that may be due in connection with this submission, or to credit any overpayment of same, to Deposit Account No. 033975 Order No. 021058-0257402.

Date: May 13, 2009
PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. Box 10500
McLean, VA 22102
703 770.7900


ERIC B. COMPTON
Reg. No. 54806